

REMARKS

This is a timely reply to the Final Office Action of December 5, 2002. In that Final Office Action, the Examiner maintains the withdrawal from consideration of Claims 11 – 13, 15 – 21, 23 and 25 – 30. The Examiner rejects Claim 10 under 35 U.S.C. 112, second paragraph. The Examiner also rejects Claims 5 – 10, 14 and 43 under 35 U.S.C. 103(a). The grounds for rejection are traversed below.

Claim Rejection - 35 U.S.C. § 112, second paragraph

In Section 3 of the Office Action, the Examiner rejects Claim 10 as being indefinite. Specifically, the Examiner asserts that the recitation of “truncated conical collar” is indefinite as to how it relates to the “annular collar” recited in Claim 43. Claim 10 has been amended to recite “wherein said annular collar comprises a truncated conical collar.” The Applicant submits that this amendment is supported by Claim 10 as previously on file and in the specification at Fig. 19. The Applicant, therefore, submits that the amendment to Claim 10 adds no new matter to the application and may be properly entered. The Applicant further submits that the amendment to Claim 10 overcomes the rejection based on 35 U.S.C. 112, second paragraph.

Claims Rejection - 35 U.S.C. § 103(a)

In Section 5 of the Office Action, the Examiner rejects Claims 5 – 10, 14 and 43 under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application GB 2,263,660 taken together with Christine et al. (U.S. Patent No. 3,538,997). Specifically, the Examiner asserts that Christine teaches “a conveyor of plural templates 15, each template including plural receiving holes each having an annular collar 22 for retaining a container 35, the annular collar having an interior dimension smallest in a region furthest from the exterior surface of the template.” The Examiner further asserts that it would have been obvious to one skilled in the art to modify GB ‘660 by providing the receiving seats as a receiving seat with an annular collar having an interior dimension in a region furthest from the exterior surface of the template, as allegedly disclosed in Christine. The Examiner asserts that the motivation for such a modification would be to more securely retain the thermoformed containers on the conveying template and to allow the

templates to be used for differently sized or shaped containers by replacing the annular collars with differently sized/shaped collars.

The Applicant submits that the Examiner has relied upon nonanalogous art in combining GB '660 with Christine. The Examiner is reminded that "in order to rely on a reference as a basis for rejection, the reference must be either in the field of an applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP 2141.01(a) quoting *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). The Christine reference combined relates to "endless conveyors having a series of openings therein for the reception of containers to be filled by associated packing mechanism." (See Christine, col. I, ll. 9 – 11). The Applicant's invention relates to "a thermoforming apparatus for thermoformable materials in ribbon or sheet form." (See specification, p. 1, ll. 6 – 8). Clearly, these are two different fields of endeavor.

Christine merely teaches an apparatus that holds a container so that it can be filled from an associated packing mechanism. The present application is directed at solving the problem of reducing the inertial shifting that occurs when thermoformed articles are held within a receiving template so that the required precision positioning of the thermoformed articles for subsequent operations is not lost. See p. 2, ll. 16 – 25 of the present specification. Hence, the Christine reference and the claimed invention are directed at two separate problems. Christine is directed at holding a container so that it can be filled with a product, while the claimed invention is directed at holding a thermoformed article so that further operations can be performed on the article.

Therefore, the Applicant submits that the Christine reference is nonanalogous prior art and may not be properly combined with the GB '660 reference. That is, the Applicant submits that Christine is neither in the field of the applicant's endeavor nor is reasonably pertinent to the particular problem with which the Applicant was concerned. Hence, the Applicant submits that the Examiner can not establish a *prima facie* case of obviousness based on the citation of Christine.

Further, the Examiner is reminded that to establish a *prima facie* case of obviousness, the Examiner must show: (1) that there is some suggestion or motivation to modify the reference or to combine reference teachings; (2) that there is a reasonable expectation of success; and (3) that the prior art reference or references teach or suggest each and every claim limitation. See MPEP 2142. Further, the suggestion or motivation to modify or combine and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. The Applicant submits that the Examiner has neither adequately shown a motivation to combine the references in the manner done by the Examiner nor has the Examiner shown that the asserted combination teaches each and every element of the rejected claims. Therefore, the Applicant submits that the Examiner has not established a *prima facie* case of obviousness based on the cited prior art, and the claims are patentable over these cited references.

The Examiner asserts that it would have been obvious to one skilled in the art to modify GB '660 by providing the receiving seats as a receiving seat with an annular collar having an interior dimension in a region furthest from the exterior surface of the template, as allegedly disclosed in Christine. The Examiner asserts that the motivation for such a modification would be to more securely retain the thermoformed containers on the conveying template and to allow the templates to be used for differently sized or shaped containers by replacing the annular collars with differently sized/shaped collars. However, the Examiner has not identified where in GB '660 the problem of secure retention of thermoformed articles is presented or even suggested. Nor has the Examiner identified where in GB '660 there is even a suggestion have templates that allow for the use of differently sized or shaped containers. The Applicant submits that the only suggestion for secure retention of thermoformed articles is provided by the Applicant's own disclosure, as is discussed above. The Applicant submits that the Examiner has improperly relied upon the Applicant's own disclosure and, therefore, has not established a *prima facie* case of obviousness based on the cited references.

Finally, even if the Examiner maintains that both references are analogous prior art and that there is a proper suggestion of motivation to combine the references, the Applicant submits that the Examiner has not shown how the combination of references teaches each and every element as set forth in the rejected claims. Specifically, Claim 43 recites a "one or more receiving disposed

within said template and communicating with said exterior surface." Fig. 2 of Christine shows the holder 22 projecting from the surface of the flight 15. Hence, the holder 22 is not "communicating with said exterior surface," but is, instead, projecting from an exterior surface. The Applicant submits that the Examiner has not shown how the combination of references teaches each and every element of Claim 43, and, therefore has not established a *prima facie* case of obviousness based on the cited references.

Therefore, the Applicant submits that Claim 43 is patentable over the cited references. The Applicant further submits that Claims 5 – 10, 14 and 45 are also patentable over the cited references at least based upon their dependence upon the patentable base Claim 43.

The Applicant further notes that in the previous Office Action, the Examiner rejected Claims 10 and 14 under 35 U.S.C. 103(a) as being unpatentable over GB '660 taken together with German '301, as applied to claims 5 – 7, 9 and 43, and further in view of Padovani (U.S. Patent No. 5,118,277). The Applicant further notes that Claim 10 was not amended in the previous response (although Claim 10 has been amended in the present response) and that Claim 14 was amended for clarity purposes. Therefore, the Applicant does not understand how Claims 10 and 14, which were previously rejected on the basis of the combination of GB '660, German '301 and Padovani '277, can now only be rejected based only on the combination of GB '660 and Christine. Therefore, the Applicant submits that the Examiner has not shown, in the present Office Action, how the combination of GB '660 and Christine teaches each and every element of Claims 10 and 14. Therefore, the Applicant submits that Claims 10 and 14 are patentable based upon their own merits over the cited references.

Conclusion

For the reasons set forth above, the Applicant submits that Claims 5 – 10, 14, 43 and 45 are allowable over the prior art that has been cited. In view of the above, reconsideration and allowance of at least Claims 5 – 10, 14, 43 and 45 of the application are respectfully solicited. Further, the Applicant notes that Claims 11 – 13, 15 – 21, and 23 are allowable based upon their dependence, either directly or indirectly, on Claim 43. That is, Claim 43 is generic to the species

claimed in Claims 11 – 13, 15 – 21 and 23. Therefore, under 37 C.F.R. 1.141(a), Claims 11 – 13, 15 – 21 and 23 are allowable based upon their dependence on Claim 43.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being facsimile transmitted to Fax No. 703-872-9311 and addressed to: Box AF, Commissioner for Patents, Washington, D.C., 20231 on

March 3, 2003

(Date of Deposit)

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Respectfully submitted,

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MARKED CLAIMS TO SHOW CHANGES MADE

10. (Six Times Amended) A thermoforming apparatus as claimed in claim 43, wherein said annular collar comprises a truncated conical collar. ~~retention means further comprises a truncated conical collar adjacent each receiving hole.~~